

## **REMARKS**

### **I. Status of Claims**

Claims 1-12 are pending in the application. Claims 1, 5, and 6 are independent. Claims 1-2, 4-7, and 9 are currently amended. Claims 10-12 are newly added.

Support for the additional language of the claims can at least be found in paragraphs [0033], [0034], as well as FIG. 2, of the Applicant's specification. Thus, the Applicant respectfully submits that no new matter is added.

Claims 1, 2, 5, and 6 stand rejected under 35 USC 102(b) as allegedly being anticipated by Tabata et al. (USP 5,833,570) ("Tabata").

Claims 4 and 9 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Tabata in view of Eguchi et al (USPGPUB 2003/0109360) ("Eguchi").

Claims 3, 7, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of their base claims and any intervening claims.

The Applicant respectfully requests reconsideration of the rejections in view of the foregoing amendments and the following remarks.

### **II. Allowable Subject Matter**

Claims 3, 7, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of their base claims and any intervening claims.

### **III. Applicant's Statement of Substance of Examiner Interview**

In compliance with M.P.E.P. 713.04, the Applicant provides this Statement of Substance of Interview concerning the interview conducted on November 13, 2009 with Examiner Coolman and Applicant's representative Daniel Shanley.

- (A) Exhibits. N/A.
- (B) Claim(s). 1-9.
- (C) References Discussed. Tabata.

- (D) Amendments. Discussed amending claims to recite “continuously changing the hydraulic pressure command value from zero.”
- (E) Principal arguments of Applicant. Tabata does not teach or suggest Applicant’s changing means, , continuously changing step, and/or second control device.
- (F) Other matters. Examiner indicated that amendments should be filed with an RCE (since they raise a new issue(s).
- (G) Results. Agreement was reached that amendments would overcome the rejections of record. Whether or not the amended claims were allowable would depend upon a further updated search.

#### **IV. Pending Claims**

Independent claims 1, 5, and 6 stand rejected under 35 USC 102(b) as allegedly being anticipated by Tabata.

The Applicant respectfully submits that claim 1 is patentable over Tabata at least because it recites, *inter alia*, “...changing means for continuously changing ***the hydraulic pressure command value from zero*** while the maintaining means maintains the rotational speed of the motor at the predetermined rotational speed.” (emphasis added)

The Applicant respectfully submits that claim 5 is patentable over Tabata at least because it recites, *inter alia*, “...continuously changing ***the hydraulic pressure command value from zero*** while maintaining the rotational speed of the motor at the predetermined rotational speed.” (emphasis added)

The Applicant respectfully submits that claim 6 is patentable over Tabata at least because it recites, *inter alia*, “...a second control device which continuously changes ***the hydraulic pressure command value from zero*** while the first control device maintains the rotational speed of the motor at the predetermined rotational speed.” (emphasis added)

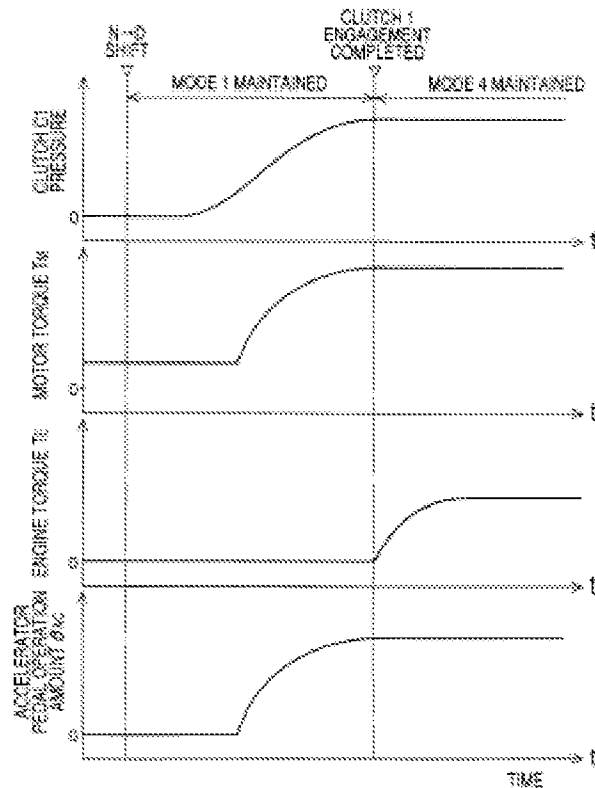
Tabata discloses that the feedback control for a motor-generator is executed *during the inertia phase* in the shift change so that the rotational speed of an input shaft of the automatic transmission or the rotational speed of an output shaft of the automatic transmission is changed respectively according to the target rotational pattern (See FIGS. 11 and 15 of Tabata) or the target output torque pattern (See FIGS. 18-19 of Tabata). In Tabata, the duty ratio is learned using the average value of the feedback control amount for the motor-generator *during the inertia phase* (See col. 26, line 24, to col. 27, line 23 of Tabata).<sup>1</sup> However, in contrast to the inventions of claims 1, 5, and 6, in Tabata, the *initial hydraulic pressure* is *not* reflected in the duty ratio.

Without waiving any argument, and to advance prosecution, claims 1, 5, and 6 are amended to further distinguish certain embodiments of the present invention from Tabata by reciting that the hydraulic pressure command value is continuously changed from zero at the initiation of the inertia phase. It is respectfully submitted that, ostensibly, in FIGS. 15 and 19 (reproduced herein below) of Tabata,  $P_{B2}$  is *not* zero at the initiation of inertia phase.

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<sup>1</sup> Similar to the art described in paragraph [0006] of the “Background” section of the Applicant’s specification.

**FIG. 19**



Accordingly, lacking any teaching and/or suggestion of the recited changing means, second control device, or the continuously changing step, Tabata does not teach and/or suggest each and every limitation of the inventions of claims 1, 5, and 6. Thus, Tabata does not anticipate the claims as alleged. It is respectfully submitted that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, the Applicant respectfully submits that the 35 USC 102 rejections are improper and should be withdrawn.

Also, it would not have been obvious to modify Tabata in the manner as claimed. As discussed in MPEP 2143.01, obviousness can *only* be established by combining or modifying the *teachings of the prior art* to produce the claimed invention where there is some *teaching, suggestion, or motivation* to do so in *the prior art itself*. *In re Kahn*, 441 F.3d 977, 986, 78

USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching \*test as a guard against using hindsight in an obviousness analysis).

Moreover, the Applicant respectfully submits that the other cited references do not identify a reason why one of ordinary skill in the art would modify Tabata in the manner as claimed by the Applicant. It is respectfully submit that, as discussed in *KSR Int'l Co. v. Teleflex, et al.*, No. 04-1350, (U.S. Apr. 30, 2007), it is necessary to identify the reason why a person of ordinary skill in the art would have been prompted to combine alleged prior art elements in the manner as claimed by the Applicant. Obviousness cannot be sustained by mere conclusory statements.

Thus, the Applicant respectfully submits that claims 1, 5, and 6 are patentable over Tabata and the cited references.

**V. Conclusion**

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Office Action is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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